

Korean Patent Application No. 10-1996-703590  
Your Ref.: PO871P5 Korea  
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### THE EXAMINER'S GROUNDS FOR REJECTION

The present application cannot be patented under Article 29, Paragraph 3, of the Korean Patent Act because the claimed invention is identical to that which is disclosed in the original specification or drawings of Korean Patent Application No. 1995-704474 (Laid-Open No. 10-1996-7001998, March 28, 1996), which was filed prior to but laid-open to the public subsequent to the filing date of the present application. Neither the inventors of the present application are identical to those of the prior-filed application, nor is the applicant at the time of filing the present application the same as that of the prior-filed application.

- Claims 1 to 36 of the present application are directed to a human *mpl* ligand polypeptide. However, the first (claiming the priority as of January 3, 1994) and the second (claiming the priority as of January 21, 1994) priority applications do not disclose the claimed full-length human *mpl* ligand polypeptide; it is not until the third priority date of February 15, 1994 that the full-length polypeptide was first disclosed in the specification and drawings of the applications from which the priority of the present application is claimed.

The cited Korean 1995-704474 application (hereinbelow "cited reference 1") relates to a polypeptide having human TPO activity, which has been proven to be the same as the *mpl* ligand. The first application from which cited reference 1 claims priority as of February 14, 1994, which is prior to said third priority date of the present application, discloses a process for the production of a polypeptide having human TPO activity by obtaining a gene encoding a region of 1-232 of human TPO amino acid sequence, and then expressing the gene in host animal cells using recombinant technology, and determining the sequence of the full-length sequence (1-332) of TPO by obtaining a gene encoding a region of 203-332 of human TPO amino acid sequence. As such, the present application is deemed to be subsequent to cited reference 1.

Claims 1 to 36 of the present application are based on the priority date that predates February 15, 1994, which is properly regarded as an actual date of priority, and fall within the scope of the invention disclosed in the specification or drawings of cited reference 1, laid-open subsequently to the present application. Therefore, the claims cannot be patented under Article 29, Paragraph 3, and Article 54 of the Korean Patent Act.

### OUR COMMENTS/RECOMMENDATIONS

Briefly, the Examiner indicated that the valid priority date of the present application is February 15, 1994, which makes the present application subsequent to the cited application

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claiming the priority date of February 14, 1994. Inasmuch as the "prior" application discloses the full-length human *mpl* ligand polypeptide, the present application lacks any novelty.

We have not fully reviewed the specification and claims with respect to this rejection. Please provide us with your comments and explanations on how to overcome this rejection. However, if you want us to provide our comments and suggestions on this rejection, please let us know by return facsimile.

We enclose herewith a copy of the cited reference and the corresponding international publication WO 95/21919 (claims only).

## Transmittal Form for Communications Containing Prior Art

Genentech File Reference: PO871P5 Korea

Foreign Office Name (e.g., EPO, JPO, etc.): The Korean Intellectual Property Office (KIPO)

Type of Communication: ☐ Search Report ☒ Office Action  
☐ Others (describe: \_\_\_\_\_)

Copies of References Included? ☒ Yes ☐ No

Date Communication Mailed by Foreign Office: May 31, 2002.

Date Communication Received by Your Office: June 1, 2002.

Date Communication Transmitted to Genentech: June 5, 2002

How Transmitted? ☒ Fax ☒ Overnight Mail ☐ E-mail  
☐ Others (e.g., regular mail)

Name of Party at Genentech/Counsel to Whom Communication Sent: Dr. Timothy R. Schwartz

Name of Person Sending Communication at Your Firm: Katie (Kuiy-dong) Lee